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glenda.orrantia@bakerbotts.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHRINIWAS LOHIA

Appeal 2008-003680
Application 09/436,920
Technology Center 2400

Decided: August 27, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
HOWARD B. BLANKENSHIP, and ST. JOHN COURTENAY III,
Administrative Patent Judges.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-26, which are all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Invention

Appellant's invention relates to data communication and a system for communicating management information. (Abstract.)

Representative Claim

1. A system for communicating management information, comprising:

a first interface card;

a second interface card; and

a management card coupled to the first interface card and the second interface card, the management card operable to:

receive a command from a client, the command identifying an interface card or a network device associated with an interface card;

establish a communication link between the client and a particular one of the first interface card and the second interface card selected in response to the command communicated by the client, wherein the communication link forms a complete path that couples at least the client to at least the particular interface card; and

communicate management information using the communication link.

Prior Art

Flood	4,937,777	Jun. 26, 1990
Schneider	6,304,895 B1	Oct. 16, 2001

Examiner's Rejections

Claims 1, 7, 14, and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 4-7, 10-14, 16, 18-21, 22, and 24-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Flood.¹

Claims 2, 3, 8, 9, 15, 17, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flood and Schneider.

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal with respect to the rejections over the prior art on the basis of claims 1 and 22. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

(1) Has Appellant shown that the Examiner has not set forth a prima facie case that the disclosure fails to support the language, "wherein the communication link forms a complete path that couples at least the client to at least the particular interface card[,] and communicate management information using the communication link?"

¹ The Flood patent issued more than one year prior to filing of the instant application (Nov. 9, 1999), and is thus a reference under 35 U.S.C. § 102(b).

(2) Has Appellant shown that Flood fails to describe a communication link that forms a complete path and which couples a client with an interface card?

(3) Has Appellant shown that Flood fails to teach a first interface card coupled to a first network device that uses a first operating system and a second interface card coupled to a second network device that uses a second operating system?

FINDINGS OF FACT

Flood

Flood describes a programmable controller for operating a machine to carry out programmed functions, which includes a plurality of program processors. Abstract.

A programmable controller 10 (Fig. 1) is housed in a rack 12, which includes slots to receive printed circuit board modules. The modules communicate through backplane 11 (Fig. 2). Col. 4, ll. 12-21.

The rack 12 (Fig. 1) contains a system controller 16, program execution processor modules 18, and remote input/output (I/O) scanner modules 20. *Id.* at ll. 22-29.

Remote I/O scanner modules 20 interface the controller 10 to external remote I/O racks 17 via serial I/O data links 15. Each remote I/O rack 17 contains local I/O modules 19 which are coupled to individual sensors and actuators on the controlled equipment. *Id.* at ll. 33-39.

The system controller 16 connects through cable 25 to a programming terminal (personal computer) 24, used to load user programs into the

programmable controller, configure its operation, and monitor its performance. The terminal 24 may be disconnected from the system controller 16 if further monitoring is not required. *Id.* at ll. 50-61.

The system controller 16 may also connect via cable 26 to a local area network 28, over which it may receive data and programming instructions, as well as issue status information and report data to a host computer. A central host computer or terminal may thus program and control a plurality of programmable controllers on a factory floor. *Id.* at ll. 61-68; col. 6, ll. 11-16.

PRINCIPLES OF LAW

Claim Interpretation

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim

scope be removed, as much as possible, during the administrative process.”
In re Zletz, 893 F.2d at 322.

Written Description

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the written description requirement. *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000).

ANALYSIS -- WRITTEN DESCRIPTION

Claims 1, 7, 14, and 21 are rejected under 35 U.S.C. § 112, first paragraph. The Examiner finds that “wherein the communication link forms a complete path that couples at least the client to at least the particular interface card; and communication management information using the

communication link” was not described in the Specification in such a way to show possession at the time of invention.² (Ans. 5.)

Appellant responds that the disclosure at “[p]age 9, [l]ines 24-27 (emphasis added)” states that “a communication link 22 comprises any switched communication path that couples client 18 to an interface card 14 and communicates management information using any suitable communication protocols, standards, and/or formats.” (App. Br. 18.) We do not find these words at the indicated section, but we do find them at page 6, lines 26 through 30 of the Specification.

Appellant also submits that Figure 1 supports a particular embodiment of the language in controversy. “In particular FIGURE 1, illustrates a path completed between client 18 and the interface card 14 on the far left side of FIGURE 1.” (App. Br. 18.)

We reproduce the Examiner’s complete response, including whitespace, to Appellant’s arguments. “Response to applicant’s argument is as follows.

For the above reason, it is believed that the rejections should be sustained.” (Ans. 16.)

² Claims 1, 7, 14, and 21 are independent claims. Why the Examiner rejects these claims, but not the dependent claims that incorporate the limitations of the respective base claims, including the “wherein” clause for which the independent claims are rejected, is unknown.

The Examiner has thus not explained why the disclosure relied upon by Appellant fails to support the aspect of the presently claimed invention for which the claims are rejected under § 112, first paragraph. Although the disclosure does not provide *in haec verba* support for the invention now claimed, we conclude that the Examiner has not set forth a prima facie case of unpatentability under § 112, first paragraph, for lack of written description support.

We therefore do not sustain the § 112, first paragraph rejection of claims 1, 7, 14, and 21.

ANALYSIS -- PRIOR ART

I. Appellant's Contentions

Appellant submits that, in view of an earlier appeal in this application, instant claim 1 has been amended to distinguish over the Flood reference. In particular, the claimed “communication link” has been further limited by the language “wherein the communication link forms a complete path that couples at least the client to at least the particular interface card.” Appellant submits that the recitation distinguishes over Flood, as “reasonably inferred” from the Board’s discussion in the Response to Rehearing Request in the earlier appeal. (App. Br. 20.)

With respect to Flood as applied against claim 1, Appellant submits “at no point in time does the system of *Flood* establish all portions of a ‘communication link’ so as to form a ‘complete path.’” (*Id.*) Appellant refers to material in Flood at column 7 indicating that Flood uses an arbitration circuit 40 (Fig. 3) in the system controller such that transmitted

data is temporarily stored in RAM 38. According to Appellant, only one device may be transmitting data to and from RAM 38 at a time. “As a result, no ‘communication link’ that forms a ‘complete path’ between terminal 24 and execution processors 18 is ever established, despite any indirect communication of information from terminal 24 to execution processors 18.” (App. Br. 21.)

Appellant also submits that the combination of Flood and Schneider does not teach (as recited in claim 22) “a first interface card coupled to a first network device that uses a first operating system” and “a second interface card coupled to a second network device that uses a second operating system.” Appellant argues that this lack of teaching is demonstrated by the reversal of claim 3 in the earlier appeal of the § 103(a) rejection over Flood and Schneider, which contained substantially the same limitations with regard to the interface cards and the respective operating systems. (App. Br. 22-23.)

II. Earlier Appeal

In Appeal Number 2005-0521 in this application, the Board sustained a § 102(e) rejection of claim 1 over Flood. Instant claim 1 differs from the earlier version of claim 1 by the addition of the language “wherein the communication link forms a complete path that couples at least the client to at least the particular interface card.” (*See* Decision on Appeal 2005-0521 (May 24, 2005) at 2 and 6.)

In the earlier appeal, the Board did not sustain a § 103(a) rejection of claims 3, 9, and 17 over Flood and Schneider.

We will not sustain the examiner's rejection of claims 3, 9 and 17 for essentially the reasons argued by appellant in the briefs. Specifically, the applied prior art makes no mention of first and second operating systems and of configuring management information for the operating system. The examiner's "finding" of different operating systems in Flood is nothing more than speculation and has no support in the reference. While we suspect that different devices can operate under different operating systems, and that communicated information must be configured based on the operating system, we are not permitted to substitute our opinions or beliefs for evidence lacking in the record. The examiner is required to provide a clear evidentiary record to support the rejection of each claim. The prior art applied in the examiner's rejection simply does not provide the support needed to reject claims 3, 9 and 17.

(Dec. on Appeal 2005-0521 at 12-13.)

In view of the rejections that were sustained, Appellant filed a request for rehearing that the earlier panel subsequently denied.

Appellant argues that there is no "communication link" between terminal 24 and processing modules 18. Appellant bases this argument on his position that terminal 24 and program execution modules 18 cannot concurrently access buses 31-33 of system controller 16. Thus, appellant argues that Flood never establishes a communication link between terminal 24 and processors 18. In other words, appellant's argument is apparently based on appellant's view that a "communication link" requires that the *complete path* from terminal 24 to processors 18 *must exist at the same time*.

(Dec. on Request for Rehearing in Appeal 2005-0521 (Sep. 16, 2005) at 2 (emphasis added).)

The earlier panel found that the meaning of “communication link” had not been argued in the briefs, but addressed the bounds of the recitation in the Rehearing. “We now find that the fact that data in Flood is sent from terminal 24 to processors 18 is sufficient to meet the broadest reasonable interpretation of the term ‘communication link.’” (*Id.* at 2-3.) “For purposes of this decision, and based on the record of prosecution, we simply find that a communication link exists between the terminal 24 and the processors 18 of Flood because information is transferred between them.” (*Id.* at 3.)

III. Claim 1-- § 102 over Flood

According to Appellant, Flood does not disclose a communication link between the client and an interface card in which “the communication link forms a complete path that couples at least the client to at least the particular interface card.” However, Appellant acknowledges that the language of the claim 1 “wherein” clause is not contained in the original disclosure. (*See App. Br. 18.*) As also submitted by Appellant, the original disclosure indicated that the communication link between the client and interface should be interpreted broadly, as any switched communication path that couples the client to an interface card. (*See id.*)

Appellant seems to have taken, from the Board’s discussion in the Response to Rehearing Request in the earlier appeal, that the language the “wherein” clause adds to claim 1 would distinguish over Flood. We find no such indication in the Response, but discussion of how Appellant seemed to be arguing alleged differences between claim 1 and Flood that were not required by the language of the claim that was brought on appeal.

We are not persuaded by Appellant's argument that the Flood apparatus forms no communication link within the meaning of a "complete path" as claimed because transmitted data may be temporarily stored in RAM 38 (Flood Fig. 3). Even in the particular embodiment of the invention depicted in Appellant's Figure 1, the "complete path" includes modem 30 and processor 54 (shown in Fig. 2, part of management card 12), each of which would insert processing delays in the "complete path" of the communication link. We do not see how the "wherein" clause of claim 1 can be considered to distinguish over the apparatus described by Flood, under the broadest reasonable interpretation of the claim in view of the Specification, especially since the "complete path" is described only by example, as opposed to a careful definition set forth that would exclude temporary storage of data in RAM. Even if the embodiment of instant Figure 1 differed in substance from the communication link described by Flood, we do not see why claim 1 should be limited to the details of that particular embodiment. Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d at 1323.

We are thus not persuaded of error in the § 102 rejection of claim 1 over Flood. We sustain the rejection of claim 1, and that of claims 2, 4-8, 10-16, and 18-21 which fall with claim 1.

IV. Claim 22 -- § 102 over Flood

We do not sustain the § 102 rejection of claim 22, nor that of claims 23 through 26 which incorporate the limitations of claim 22. Claims 22 and

24 through 26 are nominally rejected under 35 U.S.C. § 102(e), but the statement of the rejection in the Final Rejection and the Answer do not appear to address the claims.

Claims 3, 9, and 17 are rejected under § 103(a) over Flood and Schneider. However, claim 22 (and by reference dependent claims 23 through 26) recites limitations similar to those of claims 3, 9, and 17 with respect to a first interface card coupled to a first network device that uses a first operating system and a second interface card coupled to a second network device that uses a second operating system.

In any event, the Examiner asserts that the limitations of claims 3, 9, and 17 are taught by Flood (Ans. 10, 14-15), which was the Examiner's position on appeal in the earlier rejection of claims 3, 9, and 17. We do not sustain the § 103(a) rejection of claims 3, 9, and 17 for the same reasons we did not sustain the rejection in the earlier appeal (*supra* at 9-10).

CONCLUSIONS OF LAW

(1) Appellant has shown that the Examiner has not set forth a prima facie case that the disclosure fails to support the language, "wherein the communication link forms a complete path that couples at least the client to at least the particular interface card[,] and communicate management information using the communication link."

(2) Appellant has not shown that Flood fails to describe a communication link that forms a complete path and which couples a client with an interface card.

(3) Appellant has shown that Flood fails to teach a first interface card coupled to a first network device thus uses a first operating system and a second interface card coupled to a second network device that uses a second operating system.

DECISION

The rejection of claims 1, 7, 14, and 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejection of claims 1, 4-7, 10-14, 16, 18-21, 22, and 24-26 under 35 U.S.C. § 102(e) as being anticipated by Flood is affirmed with respect to claims 1, 4-7, 10-14, 16, and 18-21 but reversed with respect to claims 22 and 24-26.

The rejection of claims 2, 3, 8, 9, 15, 17, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Flood and Schneider is affirmed with respect to claims 2, 8, and 15 but reversed with respect to claims 3, 9, 17, and 23.

The Examiner's decision is thus affirmed with respect to claims 1, 2, 4-8, 10-16, and 18-21 but reversed with respect to claims 3, 9, 17, and 22-26.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

Appeal 2008-003680
Application 09/436,920

msc

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980